



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent APPLICATION OF

Theodore Roy Dimitroff

Group Art Unit: 3672

Appln. No.: 10/517,396

Examiner: Nicole A. Coy

Filed: November 28, 2004

Confirmation No.: 5576

Title: METHOD AND APPARATUS FOR
FORMING BORED HOLE

Attorney Dkt No.: HAM-PAUS0001

Date: October 8, 2007

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**RENEWED PETITION UNDER 37 CFR 1.181 TO WITHDRAW HOLDING OF
ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION,
OR IN THE ALTERNATIVE,
PETITION UNDER 37 CFR 1.137(b) TO REVIVE AN ABANDONED APPLICATION
FOR UNINTENTIONAL DELAY**

Mail Stop Petitions

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This response is respectfully submitted in reply to the Notice of Abandonment included in the Office Action mailed May 29, 2007 and the Decision on Petition mail dated August 6, 2007, with respect to the aforementioned patent application. (This paper is being filed timely on October 8, 2007 because October 6, 2007 is a Saturday.) Reconsideration of the Decision on Petition and Withdrawal of the Notice of Abandonment without fee is respectfully requested. In

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the alternative, Applicant petitions under 37 CFR 1.137(b) to revive the abandoned application based on unintentional delay.

Renewed Petition under 37 CFR 1.181

Applicant hereby respectfully requests that the patent application be revived without fee due to Applicant's failure to receive the mailing of the earlier Office Action, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513. The undersigned thanks Ms. Patricia Faison-Ball for discussing this matter with him on September 7, 2007. Per her suggestion, Applicant files the following arguments in support of approving this Renewed Petition to Withdraw Holding of Abandonment. Applicant respectfully submits that the law and the USPTO rules support approval of the Petition without fee.

Applicant can not find anywhere in the reasoning of Delgar Inc. v. Schuyler, or in MPEP sections 601.03 or 711.02(c) that were cited in the Decision on Petition mailed date August 6, 2007 dismissing the previous Petition filed on June 15, 2007, that supports the Senior Petitions Attorney, Patricia Faison-Ball's dismissal of the petition nor her requirement that Applicant submit evidence "that the address of record had been changed with the USPTO at the time the non-Final Office Action was mailed," (Decision on Petition Mailed August 6, 2007.) The fact that there is clear evidence in the USPTO records showing that the Office Action mailed on the USPTO on October 12, 2006 and was returned as undeliverable on October 12, 2006 is sufficient evidence under Delgar Inc. v. Schuyler and MPEP section 711.03(c) for the USPTO to withdraw the holding of abandonment in this case without fee and re-mail the Office Action previously mailed on October 12, 2006. It is clear from the evidence in the USPTO records that the Applicant never received a copy of that Office Action and was not aware that it had been sent

until they received a copy of the Notice Of Abandonment mail date May 29, 2007. These facts are sufficient under the law and USPTO rules.

In the Delgar Inc. v. Schuyler case the court reasoned that the Applicant should be able to have the application revived without fee because, as the judge stated, “it is difficult for me to believe that the notice was or was not received, when these people [Applicant and their attorney], who have every interest in its receipt, apparently acted on the assumption that it never came.” Delgar Inc. v. Schuyler, 172 USPQ 513. This same reasoning applies to the present patent application and situation, whether or not the prior attorney, Mr. Kenneth R. Schaefer, notified the USPTO of an address change. That fact should not be and is not controlling in this situation according to the law and the rules. The attorney and Applicant had every reason to want to receive the Office Action mailed on October 12, 2006; however because of a policy by the U.S. Postal Service to have a change of address expire after a certain period of time, unknown to the attorney or Applicant, the Office Action was sent back to the USPTO and never received or docketed for response by the attorney or Applicant.

Applicant notes that for good reasons, the reasoning of the Delgar Inc. v. Schuyler and MPEP section 711.03(c) does not depend on a determination of placing fault on either the Applicant (or Applicant’s attorney), the U.S. Postal Service, or the USPTO for a mailing not being completely accomplished; but merely on proof that the mail appears to not have been received by the Applicant or the Applicant’s attorney. In this case, there is clear proof (as admitted by the USPTO) in the USPTO records that the Office Action dated October 12, 2006 was never completed to the Applicant’s attorney or the Applicant. It is instructive that according to USPTO MPEP section 711.03(c) allows a Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action to be approved if a petitioner provides two items: a

statement “that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in the practitioners statement.” MPEP section 711.03(c)(1)(A). This information may be provided to prove that the Office communication was not received. It is clear that if the attorney docketing information shows, and that attorney attests to the fact, that the Office communication was not received, that evidence alone, which only establishes the fact that the Office communication was not received, is sufficient for the USPTO to revive the patent application. There is no requirement in MPEP section 711.03(c) (or Delgar Inc. v. Schuyler) for the practitioner or the USPTO to investigate and determine who, if anyone, might have been at fault for lack of diligence, negligence, etc. (The undersign notes that the typical approach for providing docketing information and the undersigned attesting to such facts of non-receipt in this case was not followed in this case because the case was transferred to the undersigned after the abandonment of the case and Mr. Kenneth R. Schaefer suspension by the USPTO as a practitioner.) The only exception to this general rule noted in MPEP section 711.03(c) is “if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).” That is clearly not the case in the present patent application. The evidence in the USPTO records clearly shows that the attorney and Applicant never received the Office Action mailed on October 12, 2006 because the U.S. Postal Service returned it to the USPTO. If blame, lack of diligence, or negligence is relevant, then in this patent application prosecution one would have to wonder whether the USPTO is not at fault or

should be blamed for not trying to send out the Office Action again after receiving the notice from the U.S. Postal Service on October 23, 2006 that the Office Action mailed October 12, 2006. The USPTO had to have known that the attorney and Applicant was not aware of the Office Action mailed October 12, 2006, but took no further action to try to notify them. It is clear from the file history that the Notice of Abandonment mailed on May 29, 2007 was delivered (not returned to the USPTO) even though no change of address had been filed by Mr. Kenneth R. Schaefer. Therefore, based on the law, the USPTO rules, and the facts of the present patent application, the undersigned is mystified as to how the USPTO could possibly deny this Petition and the previous Petition to Withdraw Holding of Abandonment Based on Failure To Receive Office Action without fee and re-mail the Office Action to the undersign with a new mail date and new period for response. Based on the law, USPTO rules, and MPEP provisions, this Petition without fee must be approved.

Finally, Applicant notes again for the record that prior to filing the previous Petition on June 15, 2007, members of the staff in the USPTO Petitions section had already reviewed the USPTO records to confirm and give their acknowledgement of the facts at issue and provided their instructions to file the Petition To Withdraw Holding of Abandonment Based on Failure to Receive Office Action stating that that was all that was needed to revive this patent application. In a June 13, 2006 telephone conversation, the Examiner, Nicole Coy, confirmed that this information in the USPTO Image File Wrapper as provided in PAIR was correct and that the Office Action mail dated October 10, 2006 was received back by the USPTO on October 23, 2006, and never mailed again to the Attorney or Applicant before the Notice of Abandonment was mailed out by the USPTO on May 25, 2007. In a further June 13, 2006 telephone conversation with USPTO representative in the Office of Petitions, April Weiss, the undersigned

was instructed to file this Petition To Withdraw Holding of Abandonment without a fee, explain the circumstances, and the Office Action mail dated October 10, 2006 would be re-mailed with a new due date. The entire purpose of these June, 2007 telephone conversations was to ensure the undersigned filed under the proper USPTO provisions so to revive this case. Under the circumstances, Applicant is particularly disappointed to have to spend more time in preparing this Renewed Petition.

Based on the aforementioned, having complied with all the requirements of Delgar Inc. v. Schuyler, the USPTO rules, and the provisions of the MPEP, Applicant respectfully requests the Office of Petitions to approve this Renewed Petition, the Examiner to withdraw her holding of abandonment, and the USPTO to **re-date and re-mail the Office Action dated October 12, 2006 to the undersigned at the address of record for customer number 58937.**

Although the Applicant believes that there is no reasonable basis for the USPTO to deny their Renewed Petition under 37 CFR 1.181, in an abundance of caution, Applicant submits the following Petition under 37 CFR 1.137(b) in the alternative.

If the Petition under 37 CFR 1.181 is Denied, Applicant Petition in the Alternative under 37 CFR 1.137(b)

As noted above, Applicants believe that prosecution of the present patent application should be continued by the USPTO withdrawing the earlier Notice of Abandonment without fee. However, in the case that the USPTO decides to deny the present Renewed Petition, Applicant provides the following in the alternative so as to ensure that there is no further delay in the prosecution of the present patent application. So, Applicant also submits herewith according to 37 CFR 1.137(b), the require reply to the October 12, 2006 Office Action and a petition fee in

the amount of \$1540.00 as set forth in 37 CFR 1.17(m) and paid for with a credit card payment form. Further, Applicant attests that the entire delay in filing the required reply from the due date of the reply (April 12, 2007) until the filing of this grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Finally, Applicant does not believe a terminal disclaimer is required under 37 CFR 1.137(d) because this utility application was not filed before June 8, 1995.

Conclusion

Based on the aforementioned, Applicant respectfully requests that the Renewed Petition under 37 CFR 1.181 be approved and the Office Action dated October 12, 2006 be re-mailed to the undersigned. However, if the Office of Petitions decides to deny this Renewed Petition, Applicant respectfully requests that in the alternative the undersigned be notified and the Petition under 37 CFR 1.137(b) be accepted and prosecution of the present patent application be resumed accordingly. Further, if for any reason the Examiner or Office of Petitions believes that the Notice of Abandonment can not be withdrawn based on the present Renewed Petition or, in the alternative Petition to Revive, the Examiner and Office of Petitions are requested to contact the undersigned ASAP at the telephone number listed below, or on my mobile telephone at 703-731-7220, to discuss any issues that might be of concern.

Respectfully submitted,



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